

PATENT

UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Yiqun Wang et al. Confirmation No.: 2225
Serial No.: 09/784,665 Examiner: Jennifer L. Hornberger
Filing Date: February 15, 2001 Group Art Unit: 3734
Docket No.: 1001.1412101 Customer No.: 28075
For: VACUUM PREP CATHETER

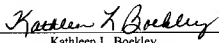
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P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

CERTIFICATE FOR ELECTRONIC TRANSMISSION:

The undersigned hereby certifies that this paper or papers, as described herein, are being electronically transmitted to the U.S. Patent and Trademark Office on this 3rd day of August 2009.

By



Kathleen L. Boekley

Dear Sir:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this Request.

This Request is being filed with a Notice of Appeal.

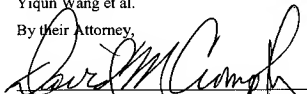
The review is requested for the reasons stated on the attached four sheets of arguments.

This Request is signed by an attorney or agent of record.

Respectfully submitted,

Yiqun Wang et al.

By their Attorney,



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8/3/09

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PRE-APPEAL CONFERENCE BRIEF

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Kathleen L. Boekley

Dear Sir:

Applicants submit that the Examiner's rejections contain at least the following clear errors and/or omissions of one or more essential elements needed for a prima facie rejection.

Claims 22, 24-28 and 35 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Ferguson et al. (U.S. Patent No. 5,637,086) in view of Foley (U.S. Patent No. 3,409,016). Applicants respectfully submit this rejection is made in error. Independent claim 22 recites in part, "a seal member releasably attached to the flanged end and covering the opening." As can be seen, claim 22 includes a seal member attached to and removable from a flanged end. Independent claim 35 recites in part, "a seal releasably attached to the proximal end surface that seals the inflation lumen." As can be seen, claim 22 includes a seal member attached to and removable from a proximal end surface. As acknowledged in the Final Office Action of February 3, 2009, Ferguson et al. do not disclose a seal member attached to the flanged end and covering the opening. The Examiner relies on Foley to provide this element.

Foley is directed toward a disposable cartridge for inflating bag catheters. In particular, Foley discloses a device for inflating a bag urethral catheter. Foley discloses a catheter is inserted through the urethra into the bladder. Once the catheter is disposed in the bladder, Foley

discloses a balloon is inflated at the distal end of the catheter so as to retain the distal end of the catheter in the bladder and provide constant drainage. The disclosure of Foley is directed primarily to a disposable cartridge for inflating the balloon. The disposable cartridge has a flexible pouch having a projecting end (e.g., needle) disposed at one end. The flexible pouch surrounds a rupturable cartridge which contains the inflation fluid. When the inner cartridge is ruptured, the inflation fluid is propelled into the catheter bag.

It is stated in the Final Office Action, "However, Foley discloses a balloon catheter with a seal/plug (fig.4, 38) disposed at the proximal most end of an inflation port (port through 36 where 38 is engaged) covering the opening though [sic] the port." As previously discussed Foley does not teach or suggest the seal/plug is releasably attached. In fact, the seal must be present during the entire use of the catheter for the catheter to function as intended. This is contrary to the present invention wherein, "After the lumen is filled, seal 240 can be removed to facilitate attachment of another inflation device."

In response to Applicants' previous arguments (see response dated March 20, 2009), it is stated in the Final Office Action, "The seal of Foley is capable of being removed from the proximal port and is, therefore, interpreted to be releasably attached to the flanged end of port." This assertion implies that the plug of Foley must inherently be removable. M.P.E.P. §2112(IV) states, "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." Nowhere does Foley teach or suggest the plug is releasably attached. In fact, Foley teaches away from a releasable seal. Foley discloses at column 1, lines 58-62, "Upon withdrawal of the needle through the self-sealing plug, the plug seals itself and the catheter bag remains inflated until the distention tube adjacent the self-sealing plug is cut away to permit the fluid to escape from the bag." Foley does not teach or suggest the plug is releasable. Instead, Foley teaches the tube adjacent the plug is cut away to allow the fluid to escape. Foley teaches away from a removable plug. MPEP 2141.02 VI states, "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)." Therefore, Foley does not teach or suggest a seal that is releasably attached.

In the Advisory Action mailed May 14, 2009, it is stated:

The limitation "releasably attached" does not imply any structure and only requires that the seal is capable of being removed or released from the rest of the catheter. The seal of catheter of Foley is capable of being released in that it is capable of being cut from the catheter. It is noted that the passage cited by applicant, col. 1, In. 58-62, as support for applicant's argument that Foley does not disclose a releasable seal does not refer to Foley's invention but to conventional inflatable bag catheters. However, the passage provides evidence that it is known to cut the seal from the rest of the catheter. Furthermore, it supports the examiner's position that one is capable of releasing the seal of Foley by cutting it away from the catheter.

It is noted that Applicants refer to text that does not refer to Foley's invention because Foley's invention is directed toward a method and a device for inflating a bag, and not the structure of a catheter. Assuming, arguendo, that one were to modify Ferguson et al. to include a seal that is cut away, one would not arrive at the device as currently claimed. For example, Foley discloses the distention tube adjacent the plug is cut away. If one were to cut the presently claimed catheter adjacent the seal, one would be cutting the catheter while it is still in use thereby rendering it damaged and useless, which one of ordinary skill in the art would clearly not do. Further, if one were to cut adjacent to the presently claimed seal, the seal member would still be attached to the flanged end and thus not releasably attached to the flanged end.

For at least the reasons set forth above, Ferguson et al. do not teach each and every element of independent claims 22 and 35. Foley does not teach what Ferguson et al. lack. Thus, even if one were to combine Ferguson et al. and Foley, one would not arrive at the device as claimed. Furthermore, there is no motivation, suggestion or other reason for one of ordinary skill in the art to modify Ferguson et al. or Foley to achieve the device as claimed. The rejection is thus in error and should be withdrawn. Applicants submit that claims 24-28 are also in condition for allowance as they depend from claim 22 and add significant limitations to further distinguish them from the prior art.

Claim 30 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Ferguson et al. (U.S. Patent No. 5,637,086) in view of Foley (U.S. Patent No. 3,409,016) and in view of Walker (U.S. Patent No. 5,322,513). Applicants respectfully traverse the rejection.

For at least the reasons set forth above, Ferguson et al. do not teach each and every element of independent claim 22. Foley and Walker do not teach what Ferguson et al. lack. Thus, even if one were to combine Ferguson et al. and Foley and Walker, one would not arrive at the device as claimed. Furthermore, there is no motivation, suggestion or other reason for one of

ordinary skill in the art to modify Ferguson et al., Foley, or Walker to achieve the device as claimed. The rejection is thus in error and should be withdrawn.

For at least the reasons mentioned above, all of the pending claims are allowable over the cited prior art. Reconsideration and further examination are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

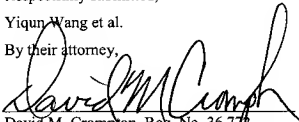
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